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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,571	12/17/2001	Vau Sheung Cheung	MR3003-9	6247

4586 7590 08/07/2003

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT PAPER NUMBER

2876

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/015,571

Applicant(s)

CHEUNG, VAU SHEUNG

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-14 is/are rejected.
- 7) ☒ Claim(s) 5,6 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:

- Claim 1, line 3: "it" is vague and should be replaced with "said card".
- Claim 1, lines 3 and 6: "able" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 9 contain the trademark/trade name "the Red Book" and "the Orange Book". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe "the thickness of the casing plate associated with the positioned card is equally a disc thickness following by Compact Disc Digital Audio Standard..." and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Dilday et al. (US 6,484,940; hereinafter "Dilday").

Re claims 1-4: Dilday teaches a card for multi-purpose using, comprising:

a card (304 in figs. 1A-1B), comprising at least one reading zone (320, 322, 318 in figs. 1A-1B), with a thickness making the card able to pass in and out of a card reader; and

a casing plate (i.e., optical drive carriage 156 in fig. 18), comprising two convex platforms on each side for positioning the card; wherein the casing plate with the positioned card is able to be inserted into an optical driver (see figs. 1A-1B and 18; col. 2, lines 17-40; col. 4, lines 28-45; col. 9, line 43 through col. 10, line 50; col. 17, lines 11-29).

Re claim 3: Dilday teaches a card, wherein the thickness of the casing plate associated with the positioned card is equally a disc thickness following by Compact Disc Digital Audio

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Standard described as the Red Book and Compact Disc Recordable (CD-R) Standard described as the Orange book (col. 2, lines 17-40; col. 4, lines 28-45).

Re claim 4: Dilday teaches a card, wherein on the card there is provided a reading area (320, 322, 318 in figs. 1A-1B), in the center of which there is an aperture fitting in a positioning member provided on the casing plate (see figs. 1A-1B and 18; col. 9, line 43 through col. 10, line 50; col. 17, lines 11-29).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dilday in view of Simmons (US 5,513,749).

Re claims 9-10 and 13-14: Dilday teaches a card for multi-purpose using, comprising:

a card (304 in figs. 1A-1B), comprising at least one reading zone (320, 322, 318 in figs. 1A-1B); and

a casing plate (i.e., optical drive carriage 156 in fig. 18); wherein the thickness of the casing plate associated with the positioned card is equally a disc thickness following by Compact Disc Digital Audio Standard described as the Red Book and Compact Disc Recordable (see figs. 1A-1B and 18; col. 2, lines 17-40; col. 4, lines 28-45; col. 9, line 43 through col. 10, line 50; col. 17, lines 11-29).

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Although, Dilday teaches a casing plate (156 in fig. 18); Dilday fails to teach or fairly suggest the casing plate comprising a transparent loading zone for positioning the card.

Simmons teaches a casing having top half 12 and bottom half 14 are made of transparent plastic (fig. 1A; col. 5, line 19 through col. 6, line 18), which serves as the casing plate comprising a transparent loading zone for positioning the card.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate transparent plastic into the casing plate as taught by Simmons to the teachings of Dilday in order to provide an aesthetic appealing to the casing plate.

Re claims 11-12: Dilday teaches the card, wherein the thickness of the disc is in accordance with the specification of the ISO 7816 (col. 2, lines 17-40; col. 4, lines 28-45).

Allowable Subject Matter

7. Claims 5-6 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

The record of prior art fails to teach a casing plate having a positioning member, wherein the positioning member has one of a smooth top surface and a plurality of tooth-shaped units.

Dilday teaches a card for multi-purpose using, comprising a card, comprising at least one reading zone, with a thickness making the card able to pass in and out of a card reader; and a casing plate, comprising two convex platforms on each side for positioning the card; wherein the casing plate with the positioned card is able to be inserted into an optical driver. However,

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Dilday fails to teach or fairly suggest a casing plate having a positioning member, wherein the positioning member has one of a smooth top surface and a plurality of tooth-shaped units.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huang (US 5,584,089) teaches CD case with a platter and cleaning means driven by a single driving device. Gartz (US 5,558,220) teaches case and tray for holding high density discs. Cooper (US 6,164,445) teaches decorative compact disc display device. Pierson (US 6,078,557) teaches method of using optical compact disc. Hansen (US 6,513,709) teaches optical transaction card system. Al-Askari (US 6,424,616) teaches insert for drives for optical storage mediums.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 703-305-1798. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-8792.


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KDN

July 16, 2003



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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